

ESTTA Tracking number: **ESTTA714236**

Filing date: **12/11/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sazerac Brands, LLC
Granted to Date of previous extension	01/06/2016
Address	10400 Linn Station Road Suite 300 Louisville, KY 40223 UNITED STATES
Party who filed Extension of time to oppose	Sazerac North America, Inc.
Relationship to party who filed Extension of time to oppose	Sazerac North America, Inc., a wholly-owned subsidiary of Sazerac Company, Inc., assigned all of its trademarks to Sazerac Brands, LLC. Sazerac Brands, LLC is a wholly-owned subsidiary of Sazerac Company Inc. Accordingly, there is privity between the filing entity and the opposer.
Attorney information	Thomas M. Hadid Cooley LLP 1299 Pennsylvania Ave., NWSuite 700 Washington, DC 20004 UNITED STATES trademarks@cooley.com, thadid@cooley.com, vbadolato@cooley.com, pwillsey@cooley.com Phone:6508497007

Applicant Information

Application No	86602658	Publication date	09/08/2015
Opposition Filing Date	12/11/2015	Opposition Period Ends	01/06/2016
Applicant	Sells, Aaron M 154 West Second St Unit 114 Boston, MA 02127 UNITED STATES		


Goods/Services Affected by Opposition

Class 033. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Alcoholic beverages, namely, rum

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3257421	Application Date	09/26/2005
Registration Date	07/03/2007	Foreign Priority Date	NONE
Word Mark	MR. BOSTON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1995/09/01 First Use In Commerce: 1995/09/01 ALCOHOLIC BEVERAGES, NAMELY FLAVORED LIQUEURS, FLAVORED BRANDY, FLAVORED SCHNAPPS, PREPARED COCKTAILS, RUM, BRANDY, CANADIAN WHISKEY, GIN, VODKA, ROCK AND RYE, SCHNAPPS, CORDIALS AND LIQUEURS		

Attachments	76647400#TMSN.png(bytes) Sazerac - NOO re SONS OF BOSTON.pdf(24463 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Thomas M. Hadid/
Name	Thomas M. Hadid
Date	12/11/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 86/602,658
For the Trademark SONS OF BOSTON
Published in the *Official Gazette* on September 8, 2015

SAZERAC BRANDS, LLC,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
AARON M. SELLS,)	
)	
Applicant.)	
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NOTICE OF OPPOSITION

Opposer Sazerac Brands, LLC (“Sazerac”), a Delaware limited liability company having its principal place of business at 10400 Linn Station Road, Suite 300, Louisville, Kentucky 40223, will be damaged by the issuance of a registration for the mark SONS OF BOSTON (the “Applicant’s Mark”), as applied for in Application Serial No. 86/602,658 filed on April 20, 2015, by Applicant Aaron M. Sells, an individual domiciled in Massachusetts with a mailing address of 154 West Second Street, Unit 114, Boston, Massachusetts 02127 (“Applicant”).

As grounds for opposition, Sazerac alleges as follows.

1. Sazerac, through its parent company, Sazerac Company, Inc. (“SCI”), markets and sells a number of different types and brands of alcoholic beverages and distilled spirits, including vodkas, whiskeys, tequilas, and specialty liqueurs. SCI has marketed and sold alcoholic beverages and distilled spirits in the United States for over a century.
2. Sazerac and its predecessor-in-interest have consistently and continually marketed and sold distilled spirits under its MR. BOSTON mark since at least as early as September 1995.

3. Sazerac owns U.S. Registration No. 3,257,421 for MR. BOSTON issued on July 3, 2007, for “alcoholic beverages, namely flavored liqueurs, flavored brandy, flavored schnapps, prepared cocktails, rum, brandy, Canadian whiskey, gin, vodka, rock and rye, schnapps, cordials and liqueurs.” In addition to being prominently displayed on labels and marketing collateral for the foregoing products, the MR. BOSTON mark appears in a popular “bartender’s guide” featured on popular retail sites like Amazon.com. By virtue of its marketing and the excellence of the underlying products, the public has come to know, rely on, and recognize the MR. BOSTON Mark as a source identifier for Sazerac’s MR. BOSTON products.

4. Sazerac’s MR. BOSTON product has grown substantially in popularity across the United States. It is well-known among consumers in the alcoholic beverage marketplace.

5. On April 20, 2015, Applicant filed an application to register the mark SONS OF BOSTON on an intent-to-use basis in connection with “[a]lcoholic beverages, namely, rum” in International Class 33.¹

6. The MR. BOSTON Mark has priority through filing and use in commerce prior to Applicant’s filing date of April 20, 2015.

7. Sazerac’s MR. BOSTON Mark is strong and well-known.

8. Applicant’s Mark is similar in sight, sound, meaning, and commercial impression to the MR. BOSTON Mark.

9. Applicant’s Mark is intended for use in connection with products that are highly related or identical to the products Sazerac offers under the MR. BOSTON Mark.

10. Applicant’s target customer base overlaps with the consumers of Sazerac’s alcoholic beverages.

¹ Sazerac does not oppose those goods and services filed for in International Class 25 and 40, which are also contained in the application.

11. As Applicant's description of goods contains no restrictions or limitations as to Applicant's channels of trade, Sazerac may assume that Applicant's Mark, like the MR. BOSTON Mark, will be used in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant's intended channels of trade for its alcohol-based products overlap with the channels of trade used by Sazerac in marketing, selling, and otherwise distributing its alcohol-based products marketed under the MR. BOSTON Mark.

12. If Applicant is permitted to register Applicant's Mark for the goods specified in the Application herein opposed, confusion resulting in damage and injury to Sazerac would occur. Persons familiar with the MR. BOSTON Mark would likely perceive Applicant's products as associated with, affiliated with, or sponsored by Sazerac. Such confusion would inevitably result in damage to Sazerac.

13. Sazerac's customers and the relevant public are likely to misapprehend Applicant's Mark as a Sazerac mark rather than a mark of Applicant and/or believe in error that goods offered under the Applicant's Mark are offered by, in association with, or under license from Sazerac.

14. Any defect, objection to, or fault found with Applicant's alcoholic beverages marketed under its SONS OF BOSTON mark would necessarily reflect on and seriously injure the reputation that Sazerac has established for its alcoholic beverage products.

15. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use its SONS OF BOSTON mark, all to the detriment of Sazerac. As such, for the reasons set forth herein, registration of Applicant's Mark should be denied pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

WHEREFORE, based on the foregoing, Opposer requests that the Board sustain this Opposition and that registration of Application Serial No. 86/602,658 be refused.

COOLEY LLP

Date: December 11, 2015

By: /s/ Thomas M. Hadid
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*Attorneys for Opposer,
Sazerac Brands, LLC*

CERTIFICATE OF SERVICE

I hereby certify that on December 8, 2015, I mailed the foregoing NOTICE OF OPPOSITION regarding *Sazerac Brands, LLC. v. Aaron M. Sells* to correspondent for Applicant by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Mr. Dan DiPietro
10 Bryn Mawr Road
Wellesley, Massachusetts 02482

with a copy to:

Mr. Adam J. Bruno
Bay State IP, LLC
One Boston Place
201 Washington St, Suite 2600
Boston, MA 02108

Date: December 11, 2015

By: /s/ Thomas M. Hadid
Thomas M. Hadid

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